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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERARD EMMER

Appeal 2010-000511
Application 10/540,141
Technology Center 1700

Decided: June 23, 2010

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and STEPHEN WALSH, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a system of manufacturing containers. The Patent Examiner rejected the claims on the ground of obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

According to the Specification, “[a] purpose of the invention is to make improvements to the methods and systems of manufacturing containers from plastic material from previously injected preforms that are thermally conditioned then transformed into containers during an expansion produced by injecting fluid into the preform.” (Spec. 1:4-6.)

Claims 22, 24 and 28 are on appeal. According to Appellant, claims 1 and 3-21 have been allowed, and claims 23, 25-27 and 29-33 have been objected to as dependent on a rejected base claim. (App. Br. 4.) Claim 22 is representative of the appealed subject matter and reads as follows, using italics to highlight the disputed limitation:

22. A system of manufacturing containers comprising:
 - a unit for thermally conditioning at least a preform;
 - an expansion unit with at least an expansion device of the said at least the preform, which expansion device is associated with a source of fluid to cause the expansion of the preform by injection of said fluid;
 - an isolating component that seals the interior of the preform from the exterior environment;
 - a connecting component that places the interior of the preform in communication with said source of fluid to cause the expansion of the preform wherein the expansion unit is a free expansion unit of at least certain of said areas of the preform; and
 - a control unit for controlling at least one injection parameter of the fluid in order to control the expansion of the preform to produce the final container,

wherein the at least one injection parameter of the fluid is controlled so that a final internal volume of the container falls within predetermined limits with respect to a reference volume.

The Examiner rejected claims 22, 24 and 28 under 35 U.S.C. § 103(a) as unpatentable over Dusterhoft.¹

Claims 24 and 28 have not been argued separately and therefore stand or fall with claim 22. 37 C.F.R. § 41.37(c)(1)(vii).

OBVIOUSNESS

The Issue

The Examiner's position is that Dusterhoft taught an apparatus for a free expansion. (Ans. 3, citing Dusterhoft Figs. 2 and 7, and ¶ 47.) The Examiner found that “[w]hile Dusterhoft does not specifically teach that an injection parameter of the fluid is controlled according to the instant claim 22, Dusterhoft teaches a controllable pressure apparatus (26).” (*Id.*) The Examiner further found that “[t]he apparatus taught by Dusterhoft is capable of performing the instantly claimed function which, it should be noted, is a method limitation and does not materially affect the apparatus.” (*Id.*)

Appellant first contends that “Dusterhoft's controller, which only provides a defined pressure, is not capable of performing the function of claim 22.” (App. Br. 10.) “In particular, Dusterhoft fails to disclose any monitoring equipment associated with the pressure, *e.g.*, flow rate monitoring, which would permit volumetric control.” (*Id.*) Appellant also contends that “Dusterhoft is directed to controlling the deliver[y] of localized energy to a local deformation zone to control the deformation of

¹ US 2002/0062161 A1, by Carsten Dusterhoft, published May 23, 2002.

this local portion exclusively.” (*Id.* at 11.) Thus, according to Appellant, “no volumetric control is contemplated,” and “it would not be obvious to modify Dusterhoft to control the pressure such that a final internal volume of the container falls within predetermined limits because this would destroy the principle of operation of Dusterhoft.” (*Id.*)

The issue in this appeal is whether the evidence supports the Examiner’s finding that Dusterhoft’s controller was capable of controlling pressure “so that a final internal volume of the container falls within predetermined limits with respect to a reference volume.”

Finding of Fact

1. Dusterhoft described controllable pressure apparatus (26) as follows:

The interior of the body 9—which in this case is designed as a hollow body—is connected to a controllable pressure apparatus 26 in the form of a compressed air apparatus 10 by the clamping apparatus 7. The controllable compressed air apparatus 10 serves to apply compressed air of defined pressure to the interior of the body 3 and to the side wall 2 to be deformed. However, it is also possible to use a pressure apparatus 26 which works with a hydraulic medium instead.

(Dusterhoft ¶ 47.)

Principles of Law

When determining whether a claim is obvious, an Examiner must make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

In re Swinehart, 439 F.2d 210, 213 (CCPA 1971).

Analysis

Appellant first contends that “Dusterhoft’s controller, which only provides a defined pressure, is not capable of performing the function of claim 22.” (App. Br. 10.) We disagree. Appellant has not provided any reason to think that “defined pressure” does not provide the condition recited in the wherein clause: “so that a final internal volume of the container falls within predetermined limits with respect to a reference volume.”

Appellant argues that more than Dusterhoft shows is needed, e.g., flow rate monitoring, to have volumetric control. (*Id.*) The claims on appeal do not require the apparatus to have a “volumetric control,” nor do the claims recite that flow rate monitoring is required. Instead, the apparatus is claimed to control at least one injection parameter so that the final volume falls within predetermined limits. The evidence supports the Examiner’s finding that Dusterhoft’s apparatus performs that function, and is sufficient to shift the burden to Appellant to show that Dusterhoft’s apparatus cannot perform the claimed function. See *In re Schrieber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997).

Appellant also contends that Dusterhoft’s focus is exclusively on a local deformation zone. (*Id.* at 11.) We disagree. Dusterhoft’s figures, e.g.,

Figs. 2 and 7 cited by the Examiner, show that Dusterhoft's focus was on expanding containers to certain shapes. We note again that the claimed apparatus is not defined as including a volumetric control device. We also cannot agree with Appellant, that "no volumetric control is contemplated" by Dusterhoft. Dusterhoft controlled the volume at least in order to contain the pressure, and produced containers with planned volumes. Appellant's argument that controlling pressure "would destroy the principle of operation of Dusterhoft" is unpersuasive because Dusterhoft taught using defined, i.e., controlled, pressure.

CONCLUSIONS

The Examiner's evidence was sufficient to shift the burden to Appellant to show that Dusterhoft's controller could not control pressure "so that a final internal volume of the container falls within predetermined limits with respect to a reference volume." Appellant has not met that burden.

SUMMARY

We affirm the rejection of claims 22, 24 and 28 under 35 U.S.C. § 103(a) as unpatentable over Dusterhoft.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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lp

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